

REMARKS

Applicants thank Examiner Chang for the courtesies extended to the undersigned during a telephone interview conducted on July 26, 2004. In the Office Action mailed June 2, 2004, the Examiner rejected claims 1-10, 12-14, 16-25, 27 and 32-38. Applicants traverse these rejections and request that the rejection be reconsidered prior to Appeal.

I. Claim Rejections

The Office Action of June 2, 2004 rejected claims 1-10, 12-14, 16-25, 27 and 32-38 under 35 U.S.C. 103(a), "as being unpatentable over Hopton et al. (US 6253524) in view of SU 806446 (Derwent Abstract), substantially for the reasons set forth in sections 4 of Paper No. 030104..." along with additional observations. Applicants assume that Paper No. 030104 refers to the previous Office Action (i.e., the Office Action of March 10, 2004). For clarity, the following discussion will provide the dates of the respective Office Actions of the present application upon reference thereto.

Applicants, amongst other reasons¹, traverse the rejections of the claims on the ground that Hopton et al. and SU506446 are improperly combined because there is no specific motivation to combine them. Applicants also traverse the rejections of claim 1-10, 12-14, 16-25, 27 and 32-38 on the grounds that the skilled artisan would be quite unlikely to employ the Hopton et al. in combination with the SU 806446 reference to arrive at the invention of the claims of the present application. During the Interview of July 26, 2004, the undersigned suggested that the skilled artisan would be very unlikely to modify the Hopton et al. reference with the SU 806446 reference to arrive at the invention of the claims of the present application, particularly since the Hopton et al. reference teaches that separate shelves of expandable material are advantageous as opposed to integrally formed extensions or ribs as claimed in the present application. Examiner Chang suggested to the undersigned that such an argument would be quite persuasive.

¹ Applicants reassert the arguments presented in previous Amendments, Responses or both and incorporated those arguments herein by reference.

Improper Combination

The combination of Hopton et al. with SU 806446 is improper because the skilled artisan would have been very unlikely to combine SU 806446 with Hopton et al. using the motivation provided by the Office Action.

In the case of In re Lee, the Court of Appeals for the Federal Circuit (the CAFC) wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In view of this caselaw, the Patent Office is required provide a specific motivation to combine the disclosure of one reference with the disclosure of another reference. The Office Action of June 2, 2004, provides, at best, a broad motivation rather than a specific motivation for combining Hopton et al. and SU 806446 and that broad motivation is not even provided by the references. As such, the rejection of the claims of the present application in view of the combination of Hopton et al. and SU 806446 is based upon hindsight and should be withdrawn.

The Office Action suggests, at page 3, that the skilled artisan would combine Hopton et al. and SU 806446, "motivated by the desire to reduce the cost of manufacturing for a specific automobile structural reinforcing member..." Applicants assert that this motivation is too broad to support the combining of Hopton et al. and SU 806446 to arrive at the invention claimed in the present application, particularly because this broad motivation serves to combine two references (i.e., Hopton et al. and SU 806446) that have little to do with one another.

In particular, SU 806446 merely teaches a process of manufacturing articles from thermoplastic wherein the articles can include, "thin projecting elements". Applicants find no suggestion in SU 806446 that such projecting elements would be suitable for use as an extension of a carrier of a reinforcing member with expandable material located thereon wherein, as recited for example in claim 1, "the at least one extension locally guides the expansion of the expandable material toward the internal surface of [a] ... hollow structural member". Even further, Applicants find no suggestion that SU 806446 relates to structural reinforcement, even broadly.

Because the disclosure of SU 806446 is quite unrelated to the disclosure of Hopton et al., the Office Action, by necessity, used a very broad motivation to combine the two references. This broad motivation fails the requirement of In re Lee, which requires a specific motivation and this broad motivation is evidence that the rejection in the Office Action is based upon hindsight. As such, applicants request that the rejections based upon the combination of Hopton et al. and SU 806446 be withdrawn.

In addition to the lack of proper motivation for combining Hopton et al. and SU 806446, the actual teachings of Hopton et al., make it highly unlikely that the skilled artisan would substitute the teachings of SU 806446 into Hopton et al. to arrive at the invention claimed in the present application. The Office Action of March 10, 2004, at

page 3, admits that, "Hopton lacks a specific teaching that the carrier and the extension are integrally molded with the same material..." but then suggests that SU '446 teaches a process, "for forming extruded hollow profiled articles from thermoplastics having a complex configuration with thin projecting elements as various constructions in automobiles." The skilled artisan, however, would not have been motivated to combine Hopton et al. with SU 806446 because Hopton et al. reads, at col. 2, lines 34-38, that, "By providing the directional foaming shelf as a separate element from the carrier, one carrier can be used for a variety of different applications by merely substituting different directional foaming shelves." Thus, Hopton et al. teaches the advantage of having a "foaming shelf" [which, according to the Office Action includes the at least one extension of claim 1] that is separate from a carrier rather than integrally molded therewith as in the present application. The skilled artisan would be very unlikely to look to a reference such as Hopton et al., which teaches the advantage of separate shelves and arrive at a reinforcing member with integral extensions or rib mouldings. On this ground, Applicants respectfully request that the claim rejections based upon the combination of Hopton et al. and SU 806446 be withdrawn.

Lack of Prima Facie Case of Obviousness

Applicants traverse the rejection of at least claim 38 of the present application on the ground that the Office Action of June, 2004 has ignored or glossed over language presented in claim 38 of the application to arrive at unwarranted obviousness rejections under 35 U.S.C. § 103. As such, the rejections posited by the Office Action fail to assert a prima facie case of obviousness under 35 U.S.C. § 103. As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 38 of the present application reads that the member, "includes an additional pair of opposing rib mouldings extending the length of said structural reinforcing member, said pairs of rib mouldings being spaced apart laterally from

each other". The Office Action of June 2, 2004 does not appear to mention the lateral spacing of the pair of ribs. Thus, the Office Action fails to assert a prima facie case of obviousness for at least claim 38 of the present application. Applicants respectfully request that the rejections of claim 38 under 35 U.S.C. § 103 be withdrawn.

Improper Reference

Applicants additionally traverse the rejection of at least claim 35 on the ground that U.S. Patent 6,641,208 was improperly used in the Final Office Action of June 2, 2004. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." is typically improper.

Applicants contend that U.S. patent 6,641,208 or at least the information contained therein was already of record when the Office Action of March 10, 2004 was issued. As such, it is improper to prevent a final rejection to claim 35, which was not amended in view of the Office Action of March 10, 2004.

II. Terminal Disclaimer

A terminal disclaimer has been submitted herewith to overcome the rejections, which employ U.S. patent 6,641,208 or U.S. Patent 6,358,584. If rejections against any of claims 1, 21 or 35 are withdrawn based upon the above, Applicants request that the terminal disclaimer not be entered. If rejections against any of claims 1, 21 or 35 are not withdrawn based upon the above, Applicant request that the terminal disclaimer be entered.

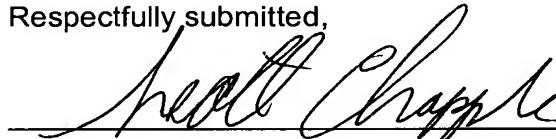
CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

Dated: 7-28, 2004

A handwritten signature in cursive script, appearing to read "Scott A. Chapple", is written over a horizontal line.

Scott A. Chapple (Reg. No. 46,287)
DOBRUSIN & THENNISCH PC
401 S. Old Woodward Ave., Ste. 311
Birmingham, MI 48009

(248) 593-9900
Customer No. 25215